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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALFRED THOMAS,
DUNCAN F. BROWN,
LAWRENCE E. DEMAR, and
SCOTT D. SLOMIANY

Appeal 2010-005110
Application 10/090,685
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

An oral hearing was held on Jan. 21, 2011.

STATEMENT OF THE CASE

Thomas, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 25-48 and 50-52. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The invention relates to “an apparatus and method for playing a new Keno-style wagering game.” Specification 1:11-12.

Claim 25, reproduced below, is illustrative of the subject matter on appeal.

25. A game playing apparatus for a game of chance, comprising:
 - a game display;
 - an operating system for said game apparatus including a processor, said processor having a program effecting play of said game of chance, said program having at least one payout table and a random number generating subroutine, said operating system further including a memory;
 - an input device through which a player provides a control input to said game apparatus;
 - a wagering input device;

² We have considered the Appellants’ Appeal Brief (“App. Br.,” filed Jun. 8, 2006) and Reply Briefs (“Reply Br. I,” filed Nov. 3, 2006, and “Reply Br. II,” filed Aug. 17, 2009), and the Examiner’s Answers (“Answer I,” mailed Sep. 5, 2006, and “Answer II,” mailed Oct. 5, 2009).

a payout device;

 said operating system: driving said display to present a plurality of game element locations; registering a selection input by a player of game element locations, where said program limits said selection to less than all of said plurality of game element locations; registering a wager input by the player upon an outcome of said game of chance; determining a game element indicium from a set of gameplay indicia to be displayed in at least said selected game element locations for a gameplay condition, said game element indicium to be displayed in each instance being randomly assigned for each said game element location from the entirety of said set of game element indicia displaying said randomly determined indicium for each said selected game element location; determining an outcome of said game of chance based upon said gameplay condition; and providing a payout, if any, according to a winning condition being determined as established by said payout table.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Simunek	US 5,401,024	Mar. 28, 1995
Tarantino	US 6,702,671 B2	Mar. 9, 2004

The following rejections are before us for review:

1. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tarantino.
2. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Simunek.
3. Claims 37, 38, and 44-46 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tarantino and Simunek.

ISSUES

Did the Examiner err in rejecting the claims over the cited prior art?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer.

Additional findings of fact may appear in the Analysis below.

ANALYSIS

We will not sustain the rejections.

There are 5 independent claims. All the claims require a system that provides for selecting game locations from a plurality of game locations whereupon a game element indicium from a set of gameplay indicia is randomly displayed in the selected game element locations. In that regard, independent claims 25, 29 and 39 call for the "game element indicium to be displayed in each instance being randomly assigned for each said game element location from the entirety of said set of game element indicia displaying said randomly determined indicium for each said selected game element location;" independent claim 47 calls for "said game element indicium to be displayed in each instance being randomly arrived at from a set of gameplay indicia for each said reel," and independent claim 50 calls for "a random selection mechanism randomly selects and displays in each instance a stop position from the entirety of said set of each of said plurality of elements on the display." These features are not described in Tarantino or Simunek.

Tarantino provides for a dice game where indicia are randomly provided in locations. However, there is no selection of game locations

from a plurality of game locations. The Examiner cited col. 13, ll. 53-60 as disclosing the selection of locations less than all locations. Answer I, 3. However, that disclosure describes a matrix as illustrated in Fig. 6 of Tarantino. There is no discussion there about selecting locations less than all locations. The Examiner also argues that Tarantino discloses selecting various columns and that this can be interpreted as selecting less than all locations, especially since a larger payout is possible by selecting more columns. Answer I, 5. However, in doing this, one does not achieve a display of a game element indicium randomly assigned for each selected game element location as claimed. In placing a bet and being provided a column, all the game locations in the column appear and in each location the indicia is randomly provided. The columns are displayed according to the number of bets made and thus the gameplay is limited to those columns displayed. See e.g., Tarantino: col. 12, ll. 52-66. But there is no selection of location that is less than all the game locations in the column provided and to which the game element indicium is randomly assigned as the claims require.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Since Tarantino does not expressly or inherently describe all the features of the claims, the rejection of claims 25-48 and 50-52 under 35 U.S.C. § 102 over Tarantino can not be sustained.

Similarly, the rejection of claims 25-48 and 50-52 under 35 U.S.C. § 102 over Simunek can also not be sustained.

We have been unable to find in Simunek disclosure of randomly displaying indicia in selected game element locations less than all locations displayed. Simunek is directed to a Keno type video game whereby locations are selected. But indicia are not randomly assigned to the selected locations. The indicia in the selected locations in Simunek do not change. The Examiner cites col. 3, ll. 1-6 and argues that it does show an embodiment where a reel-like configuration with a plurality of indicia is present at a location. However, the reel-like configuration with a plurality of indicia would display in only those locations where the locations selected by the user match those selected by the machine (see col. 3, l. 2: “matched spots”). This embodiment does not show providing for randomly displaying indicia in all the selected game element locations as claimed. Thus, Simunek does not expressly or inherently describe all the features of the claims.

The rejection of claims 25-48 and 50-52 under §103 over Simunek will also not be sustained because the Examiner’s characterization of what Simunek discloses is inaccurate. Accordingly, a *prima facie* case of obviousness has not been made out in the first instance.

We reach the same conclusion as to the rejection of claims 37, 38, and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Tarantino and Simunek.

DECISION

The decision of the Examiner to reject claims 25-48 and 50-52 is reversed.

Appeal 2010-005110
Application 10/090,685

REVERSED

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